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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
10/633,303	08/04/2003	Oded Katzman	25622	3434	
20529	7590	09/22/2006	EXAMINER		
NATH & ASSOCIATES				SANDERS JR, JOHN R	
112 South West Street				ART UNIT	
Alexandria, VA 22314				PAPER NUMBER	
				3735	

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/633,303	KATZMAN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	John R. Sanders	3735	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 04 August 2003.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1-44 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-44 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 06 November 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 11/6/03.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-8, 10-12, 14-15, 18-24, 26-33, 37-38 and 41-44 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,257,721 B1 To Hayashi et al (“Hayashi”).
3. Hayashi discloses a device for measuring eye points (pupil positions) of a subject comprising liquid crystal display elements (1R, 1L) which are detachably mounted via mounting members (3R, 3L) to a spectacle frame (F) worn by the subject (see Fig. 1, col. 5, lines 35-42). Hayashi discloses taking pupil position measurements by having the subject controlling the displays such that transmission regions of a movable graphic pattern shown on the display become aligned with the visual line position of the subject (col. 6, lines 17-64). Based on the positional relationship of the frame to the display elements, which are inputted by an appropriate adjustment routine (col. 7, lines 15-39), the eye point measurement results are determined and displayed (col. 7, lines 56-64). Measurement is taken for both near- and far-point vision (paragraph bridging cols. 6-7; paragraph bridging cols. 7-8).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9, 13, 16-17, 25, 34 and 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi.

6. Re claim 9: Although Hayashi discloses that the LCD displays are controlled by the subject, one of ordinary skill in the art would have found it obvious that a trained professionals are capable of operating the device of Hayashi such that the graphic patterns on the display are aligned with the subjects pupils.

7. Re claim 13: Hayashi does not expressly disclose the display elements disposed as the lenses in the frame. However, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to dispose the display elements as the lenses in the frame because Applicant has not disclosed that doing so provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected the device of Hayashi and applicant's invention to perform equally well with either the mounted display elements disclosed by Hayashi or the display elements disposed as the lenses as claimed by Applicant, because both embodiments would dispose said displays such that a measurement of pupil position can be obtained. Therefore, it would have been *prima facie* obvious to modify Hayashi to obtain the invention as specified in

claim 13 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art.

8.     *Re claims 16-17 and 39:* Although Hayashi does not expressly disclose compensating for optical factors such as diopter using conventional optics, doing so is a common practice in the art. Therefore, one of ordinary skill in the art would have found it obvious to modify Hayashi such that compensating optics are used since Examiner takes official notice that compensating optics are common expedients in the art.

9.     *Re claim 25:* Hayashi discloses a cable (4) connecting the displays (3L, 3R) to the control unit (10), but does not expressly disclose a wireless embodiment. At the time of the invention, one of ordinary skill in the art would have found it obvious to implement a wireless embodiment of the device disclosed by Hayashi since Examiner gives official notice that wireless control is a known and commonly implemented functionally equivalent expedient to wired control.

10.    *Re claim 34:* Hayashi discloses clip mounting means but does not disclose vacuum cup means. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify Hayashi to include vacuum cup means as the mounting means because Applicant has not disclosed that vacuum cup means provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected the device of Hayashi and applicant's invention to perform equally well with either clip or vacuum cup means because both would dispose the displays such that pupil position measurement can be taken. Therefore, it would have been *prima facie* obvious to modify Hayashi to obtain the invention as specified in claim 34 because

such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Hayashi.

11. Re claim 40: Although Hayashi does not expressly disclose said LCD displays as reflective display means, one of ordinary skill in the art is knowledgeable that spatial light modulation via LCD is effected either via refractive or reflective means and, at the time of the invention, would have found it obvious to modify the LCD displays of Hayashi in a reflective arrangement since Examiner takes official notice that reflective and refractive LCD displays are functionally equivalent expedients known in the art.

12. Claims 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi in view of U.S. Patent No. 5,561,481 to Dileo et al (“Dileo”).

13. Hayashi discloses the above limitations but does not expressly disclose a single display element shiftable between first and second lens positions. Dileo clearly teaches a spectacle frame wherein a single lens is operably switchable between the left and right lens positions (see Figs. 1-3). At the time of the invention, one of ordinary skill in the art would have found it obvious to modify Hayashi to include a single display shiftable between the two lens positions, as taught by Dileo, such that one LCD display can be used to perform pupil position measurements for both eyes.

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John R. Sanders whose telephone number is (571) 272-4742. The examiner can normally be reached on M-F 10:00 am to 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor II can be reached on (571) 272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*jrs*  
jrs  
15 September 2006

*Charles A. Marmor, II*  
Charles A. Marmor, II  
Art Unit 3735